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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,526	07/10/2003	Yen-Fu Chen	AUS920030523US1	3551

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EXAMINER
NEWAY, SAMUEL G

ART UNIT	PAPER NUMBER
2626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/617,526	CHEN ET AL.
	Examiner	Art Unit	
	Samuel G. Neway	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *7/10/03*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This is responsive to the Application filed on July 10, 2003.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.   Claims 1 – 58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/617,530 in view of

http://web.archive.org/web/20001204034200/http://www.mandarintools.com/,

Chinese-English Dictionary link.

Current Application	Co-pending Application 10/617,530
1. A method comprising:	1. A method comprising:

using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character; and using Unicode to translate the Simplified Chinese character into accented Pin Yin word and an English word.	using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character.
2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.	2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.
3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.	3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.
4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.	4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.
5. The method of claim 4 wherein the conversion table is a JAVA hashtable.	5. The method of claim 4 wherein the conversion table is a JAVA hashtable.
7. The method of claim 1 wherein Traditional Chinese character is determined without the use of an intermediate language.	6. The method of claim 1 wherein Traditional Chinese character is determined without the use of an intermediate language.
8. The method of claim 1 further comprising: displaying the Simplified Chinese character, the Traditional Chinese character, the accented Pin Yin word, and the English word.	7. The method of claim 1 further comprising: displaying the Simplified Chinese character and the Traditional Chinese character.

The current application is directed to finding the corresponding equivalent

Chinese character (Traditional and/or Simplified), the corresponding Pin Yin

word, and/or an English word to any given word (Chinese, Pin Yin, and/or

English). Copending application No. 10/617,530 is directed to finding the

corresponding Chinese character (Traditional and/or Simplified) to a given

Chinese word (Traditional and/or Simplified).

Chinese-English Dictionary teaches a method of finding the corresponding

equivalent Chinese character (Traditional and/or Simplified), the corresponding

Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or

English).

It would have been obvious to one with ordinary skill in the art at the time

the invention was made to include the various translations in order to help a non-

native Chinese speaker learn the Chinese language by, for example, giving

English translations to Chinese words.

This is a <u>provisional</u> obviousness-type double patenting rejection because

the conflicting claims have not in fact been patented.

4.   Claims 1 – 3, 8 – 11, 16 – 17, 23 – 24, 29 – 32, 37 – 40, 45 – 46, 52 – 53,

and 58 are provisionally rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1, 5 – 7, 26, 30 – 32 of

copending Application No. 10/631,070. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the above-

mentioned claims of copending Application No. 10/617,526 anticipate the claims

of the current Application.

5.

Current Application	Co-pending Application 10/631,070
1. A method comprising: using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character; and using Unicode to translate the Simplified Chinese character into accented Pin Yin word and an English word.	1. A method comprising: searching a dictionary for an entry containing a Simplified Chinese word; using Unicode to determine a Traditional Chinese word equivalent of a Simplified Chinese word; and using Unicode to translate the Simplified Chinese word into accented Pin Yin word and an English word.
2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.	5. The method of claim 1 further comprising: accepting the Simplified Chinese word as user input, wherein the Simplified Chinese word is encoded in GB2312 or Unicode.
3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.	6. The method of claim 1 further comprising: translating the Simplified Chinese word from GB2312 to Unicode.
8. The method of claim 1 further comprising: displaying the Simplified Chinese character, the Traditional Chinese character, the accented Pin Yin word, and the English word.	7. The method of claim 1 further comprising: displaying the Simplified Chinese word, the Traditional Chinese word, the accented Pin Yin word, and the English word; and wherein the font size of the Simplified Chinese word and the font size of the Traditional Chinese word is user configurable.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7.   Claims 18 and 47 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

        Claims 18 and 47 recite the limitation "wherein the Pin Yin word is an

unaccented Pin Yin word to a hybrid Pin Yin word." It is believed the limitation

should read "wherein the Pin Yin word is an unaccented Pin Yin word or [to] a

hybrid Pin Yin word", and it will be treated as such.

8.   Claims 23 and 52 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

        Claims 23 and 52 recite the limitation "the accented Pin Yin word" in the

first line. There is insufficient antecedent basis for this limitation in the claim.

9.   Claims 30 – 58 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

        Claims 30 – 58 recite the phrases "program product" and "computer-

usable medium"; these phrases are not defined in the specification and it is not

clear what they are meant to cover.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11.   Claims 1 – 7, 9 – 15, 17 – 22, 24 – 28, 30 – 36, 38 – 44, 46 – 51, and 53 – 57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 – 7, 9 – 15, 17 – 22, 24 – 28, 30 – 36, 38 – 44, 46 – 51, and 53 – 57 appear to be directed to an abstract idea rather than a practical application of the idea. The claims do not result in a physical transformation nor do they appear to provide a tangible result. For example, merely determining the Traditional Chinese character equivalent to a Simplified Chinese character is nothing more than a thought or a computation within a processor. It fails to use or make available for use the result of the determination to enable its functionality and usefulness to be realized.

One possible practical application of the abstract idea is put forth in claim 8 where the result is displayed.

12.   Claims 30 – 58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 30 – 58 recite the limitation "wherein the computer usable medium comprises instructions". These instructions should be capable of being executed by a computer in order to realize the computer program's functionality.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14.   Claims 17 – 20, 22 – 23, 46 – 49, 51 – 52 are rejected under 35

U.S.C. 102(b) as being anticipated by Chinese-English Dictionary

(http://web.archive.org/web/20001204034200/http://www.mandarintools.com/).

Claim 17:

Chinese-English Dictionary discloses a method comprising: using

Unicode to translate a Pin Yin word into a Traditional Chinese character, a

Simplified Chinese character, and an English word ("searches can be conducted

by Chinese (using either the GB, Big5, or Unicode encodings), ... results will

show the Chinese word, the Pin Yin representation of the word, and the English

definition", page 1).

Claim 18:

Chinese-English Dictionary discloses the method of claim 17 wherein the

Pin Yin word is an unaccented Pin Yin word to a hybrid Pin Yin word ("you can

include or exclude tone numbers, ... you would type "dian shi ji" or "dian4 shi4

ji1"...", page 1).

Claim 19:

Chinese-English Dictionary discloses the method of claim 17 further

comprising: accessing a dictionary to determine the Traditional Chinese

character and the English word ("CEDICT dictionary", page 1).

Claim 20:

Chinese-English Dictionary discloses the method of claim 17 further

comprising: accessing a conversion table to determine the Simplified Chinese

character ("searches can be conducted by Chinese (using either the GB, Big5, or

Unicode encodings), ... results will show the Chinese word", page 1. Note that a

conversion table is inherent in the determination of equivalent characters).

Claim 22:

Chinese-English Dictionary discloses the method of claim 17 wherein

Simplified Chinese character is determined without the use of an intermediate

language ("searches can be conducted by Chinese (using either the GB, Big5, or

Unicode encodings), ... results will show the Chinese word", page 1. Note that

the Chinese word can be selected to be either Simp. Chinese (GB) or Trad.

Chinese (Big5), as shown on top of page 1).

Claim 23:

Chinese-English Dictionary discloses the method of claim 17 further

comprising: displaying the accented Pin Yin word, the Traditional Chinese

character, the Simplified Chinese character, and the English word ("results will

show the Chinese word", page 1. Note that the Chinese word can be selected to

be either Simp. Chinese (GB) or Trad. Chinese (Big5), as shown on top of page

1).

Claims 46 – 49, and 51 – 52:

Claims 46 – 49, and 51 – 52 are similar in scope and content to claims 17

– 20, and 22 – 23; therefore claims 46 – 49, and 51 – 52 are rejected with the

same rationale.

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

16.   Claims 1 – 4, 6 – 12, 14 – 16, 24 – 26, 28 – 33, 35 – 41, 43 – 45, 53 – 55,

and 57 – 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Chinese-English Dictionary

(http://web.archive.org/web/20001204034200/http://www.mandarintools.com/) in

view of Foolsworkshop

(http://web.archive.org/web/20021206035901/http://www.foolsworkshop.com/pto

u/).

Claim 1:

The Chinese-English Dictionary link from

http://web.archive.org/web/20001204034200/http://www.mandarintools.com/

discloses a method comprising:

using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1); and

using Unicode to translate the Simplified Chinese character into Pin Yin word and an English word ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word, the Pin Yin representation of the word, and the English definition", page 1).

Chinese-English Dictionary does not explicitly teach accented Pin Yin translations.

Foolsworkshop discloses a method of translating Pin Yin into accented Pin Yin ("converts text written in pinyin, with syllable-final tone numbers, into unicode" Note that unicode in this situation represents accented Pin Yin).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to display Pin Yin as accented Pin Yin because "many students and instructors of the Chinese language have a need to display pinyin with tone marks in their documents" so they are easier to read (Foolsworkshop, first line).

Claim 2:

Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is

encoded in GB2312 or Unicode ("return the results in GB ... or Unicode", page

1).

Claim 3:

Chinese-English Dictionary and Foolsworkshop disclose the method of

claim 1, Chinese-English Dictionary further discloses: translating the Simplified

Chinese character from GB2312 to Unicode ("return the results in GB ... or

Unicode", page 1).

Claim 4:

Chinese-English Dictionary and Foolsworkshop disclose the method of

claim 1, Chinese-English Dictionary further discloses: accessing a conversion

table to determine the Traditional Chinese character ("searches can be

conducted by Chinese (using either the GB, Big5, or Unicode encodings), ...

results will show the Chinese word", page 1. Note that a conversion table is

inherent in the determination of equivalent characters).

Claim 6:

Chinese-English Dictionary and Foolsworkshop disclose the method of

claim 1, Chinese-English Dictionary further discloses accessing a dictionary to

determine the Traditional Chinese character ("CEDICT dictionary", page 1)

Claim 7:

Chinese-English Dictionary and Foolsworkshop disclose the method of

claim 1, Chinese-English Dictionary further discloses wherein Traditional Chinese

character is determined without the use of an intermediate language ("searches

can be conducted by Chinese (using either the GB, Big5, or Unicode encodings),

... results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1).

Claim 8:

Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses: displaying the Simplified Chinese character and the Traditional Chinese character ("results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1).

Claims 9 – 12, 14 – 16, 24 – 26, 28 – 33, 35 – 41, 43 – 45, 53 – 55, and 57 – 58:

Claims 9 – 12, 14 – 16, 24 – 26, 28 – 33, 35 – 41, 43 – 45, 53 – 55, and 57 – 58 are similar in scope and content to claims 1 – 4, and 6 – 8; therefore claims 9 – 12, 14 – 16, 24 – 26, 28 – 33, 35 – 41, 43 – 45, 53 – 55, and 57 – 58 are rejected with the same rationale.

17.   Claims 21 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary (http://web.archive.org/web/20001204034200/http://www.mandarintools.com/) in view of Hughes ("1ICT3 Computer Science Sample Paper I", 1998, University of Dublin)

Claims 21 and 50:

Chinese-English Dictionary discloses the method of claim 17, but does not explicitly disclose using a Java hashtable.

Hughes discloses a conversion table for Morse code stored in a Java

hashtable ("The conversion table for Morse code can be stored in a Java

Hashtable object", page 4, question 6).

Therefore it would have been obvious to one with ordinary skill in the art at

the time of the invention to use a Java hashtable as the conversion table in

Chinese-English Dictionary because Java is able to run on any platform.

18.   Claims 5, 13, 27, 34, 42, and 56 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Chinese-English Dictionary

(http://web.archive.org/web/20001204034200/http://www.mandarintools.com/) in

view of Foolsworkshop

(http://web.archive.org/web/20021206035901/http://www.foolsworkshop.com/pto

u/) and in further view of Hughes ("1ICT3 Computer Science Sample Paper I",

1998, University of Dublin)

Claims 5, 13, 20, 27, 34, 42, and 56:

Chinese-English Dictionary and Foolsworkshop disclose the method of

claim 1, but do not explicitly disclose using a Java hashtable.

Hughes discloses a conversion table for Morse code stored in a Java

hashtable ("The conversion table for Morse code can be stored in a Java

Hashtable object", page 4, question 6).

Therefore it would have been obvious to one with ordinary skill in the art at

the time of the invention to use a Java hashtable as the conversion table in

Chinese-English Dictionary because Java is able to run on any platform.

Conclusion

19.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Xing (US PGPub 2003/0115040) discloses a method of translating a domain name entered in one of many different languages into its corresponding English domain name using Unicode.

Tan et al. (USPN 6,314,469) discloses a method of identifying the encoding type of a domain name, converting the encoding to Unicode and translating the Unicode representation to an ASCII representation.

Zhong (USPN 5,319,552) discloses a method of converting Pin Yin into corresponding Zhu Yin (Traditional Chinese) and vice versa using conversion tables.

20.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

SN

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